

# SUMMARY OF FINAL DECISIONS ISSUED BY THE TRADEMARK TRIAL AND APPEAL BOARD

December 5-9, 2005

| Date Issued | Type of Case(1)                                                                    | Proceeding or Appn. No. | Party or Parties                                                  | TTAB Panel(2)                | Issue                                                                                                                                                            | TTAB Decision                                                  | Opposer's or Petitioner's Mark and Goods or Services                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           | Applicant's or Respondent's Mark and Goods or Services                                                                                                                                                                                             | Mark and Goods Cited by Examining Attorney | Examining Attorney | Citable as Precedent of TTAB                                                                            |
|-------------|------------------------------------------------------------------------------------|-------------------------|-------------------------------------------------------------------|------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------|--------------------|---------------------------------------------------------------------------------------------------------|
| 12-2**      | OPP<br>OPP<br>[Re-designation of Decision of 9/20/05 as Citable Precedent of TTAB] | 91116355<br>91124847    | Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc. | Quinn*<br>Hairston<br>Rogers | 2(d); dilution; counterclaim for cancellation on the grounds of (1) abandonment and (2) non-use as to some of the services covered by the opposer's registration | Opposition Dismissed; Counter-claim for cancellation dismissed | "CAREFIRST"<br>[collective membership mark for indicating membership in an organization of persons and medical providers in health maintenance, preventive medicine, prepaid medical plans, reduced health costs, and programs on fitness, prenatal care, substance abuse, and other health-related topics] and [newsletters pertaining to health care, medical care and membership services; underwriting and administration services, on a prepayment basis, relating to emergency medical care, <i>etc.</i> ; educational services, conducting seminars, classes, and workshops and lectures on nutrition, infant care, <i>etc.</i> ; health care services in the nature of an HMO, and a number of other related services] | "FIRSTCAROLINA-CARE" [healthcare insurance claims administration services, third-party insurance claims administration services, and underwriting insurance for prepaid healthcare; health care in the nature of health maintenance organizations] |                                            |                    | Yes<br>[Decision of 9/20/05 originally marked not citable; decision redesignated as citable on 12/2/05] |

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(2) \*=Opinion Writer; (D)=Dissenting Panel Member; \*\*Inadvertently omitted from report for week of November 28-December 2, 2005

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| 12-5        | EX              | 76578800                | Kraft Tool Co.                                  | Bucher Grendel* Kuhlke                                     | Section 6 disclaimer requirement (of the word BARBELL) [Note: Applicant has already disclaimed the words MASONRY and JOINTER] | Refusal Affirmed                                                     |                                                                                                                                                                                                                                                                                                                                                                   | "MASONRY BARBELL JOINTER" (and design) [hand tools, namely, masonry jointers]                                                      |                                            | Altree             | No                           |
| 12-5        | EX              | 78238339                | L.L. Bean, Inc.                                 | Bucher* Holtzman Drost                                     | 2(d)                                                                                                                          | Refusal Affirmed                                                     |                                                                                                                                                                                                                                                                                                                                                                   | "ORION" [fishing rods and reels]                                                                                                   | "ORION" [golf clubs]                       | Ellis              | No                           |
| 12-5        | OPP (SJ)        | 91125729                | Virgin Enterprises Limited v. Enrique Rodriguez | Hairston Holtzman Walsh [Opinion "By the Board" (Goodman)] | 2(d)                                                                                                                          | Opposition Sustained (Opposer's motion for summary judgment granted) | 15 pleaded registered marks and a number of unregistered marks, all comprising or incorporating the word "VIRGIN" [a wide variety of goods and services, including computer media and accessory products, computer software, CDs, computer games, audio and video discs, retail store services, travel related services, and transportation and airline services] | "VIRGINVISIONS" [computer screen savers recorded on various data storage media, sold as a unit with a mailer usable as a postcard] |                                            |                    | No                           |

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| 12-5        | OPP             | 91152350                | Softel Communications, Inc. v. Isoftel, Inc. | Holtzman Drost Zervas* | 2(d)                                      | Opposition Sustained in all four classes                                                    | "SOFTTEL" [ <i>in Class 37</i> : installation of telecommunication speech recognition and computer networking products; <i>in Class 42</i> : product development and consultation in the field of telecommunications] | "ISOFTTEL" [ <i>in Class 35</i> : telecommunications billing, sales volume tracking, <i>etc.</i> for telecommunications companies; computerized tracking and tracing of packages in transit; <i>in Class 36</i> : telecommunications pre-pay and post-pay calling card services; <i>in Class 38</i> : cellular telephone services, telephone services, <i>and other telecommunication services</i> ; <i>in Class 42</i> : computer programming for others, settlement negotiation services for telecommunication companies, <i>and other services</i> ] |                                            |                    | No                           |
| 12-6        | EX              | 76331011                | DNI Holdings Ltd.                            | Quinn Hairston Bucher* | genericness; 2(e)(1) [merely descriptive] | Refusal Affirmed (on grounds of genericness and, in the alternative, as merely descriptive) |                                                                                                                                                                                                                       | "SPORTSBETTING.COM" [providing casino games on and through the Internet wherein there are no actual money wagers; providing contests and sweepstakes on and through a website on the Internet; providing an Internet website featuring information in the fields of gaming, athletic competition and entertainment]                                                                                                                                                                                                                                     |                                            | Keating            | Yes                          |

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| 12-6        | EX              | 76330650                | DNI Holdings Ltd. | Quinn Hairston<br>Bucher* | genericness; 2(e)(1) [merely descriptive] | Refusal Affirmed (on grounds of genericness and, in the alternative, as merely descriptive) |                                                      | "SPORTSBETTING INFO" [providing casino games on and through the Internet wherein there are no actual money wagers; providing contests and sweepstakes on and through a website on the Internet; providing an Internet website featuring information in the fields of gaming, athletic competition and entertainment] |                                                                                                                                                                                       | Keating            | No                           |
| 12-6        | EX              | 76330663                | DNI Holdings Ltd. | Quinn Hairston<br>Bucher* | genericness; 2(e)(1) [merely descriptive] | Refusal Affirmed (on grounds of genericness and, in the alternative, as merely descriptive) |                                                      | "SPORTSBET INFO" [providing casino games on and through the Internet wherein there are no actual money wagers; providing contests and sweepstakes on and through a website on the Internet; providing an Internet website featuring information in the fields of gaming, athletic competition and entertainment]     |                                                                                                                                                                                       | Keating            | No                           |
| 12-7        | EX              | 76131964                | Ambu Inc.         | Hanak*<br>Quinn Walsh     | 2(d)                                      | Refusal Reversed                                                                            |                                                      | "RES-CUE MASK" [medical apparatus, namely, reusable resuscitation mask]                                                                                                                                                                                                                                              | "HOPKINS RES Q MASK" [face mask, for medical use, with a disposable one way filter valve to protect a wearer from a victim's bodily fluids and to avoid possible cross contamination] | Dalier             | No                           |

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| 12-7        | EX              | 76286430                | Political Compliance Services, Inc.   | Walters Kuhlke* Walsh | 2(e)(1) [merely descriptive]; genericness [whether mark is registrable on the Supplemental Register] | Refusal Affirmed on grounds the mark is merely descriptive, but not on the basis of genericness [registration allowed on the Supplemental Register] |                                                      | "POLITICAL COMPLIANCE SERVICES, INC." [election law compliance service and related consultation services]                                                                       |                                            | Micheli            | No                           |
| 12-7        | EX              | 75719651                | American Automobile Association, Inc. | Quinn Hohein Zervas*  | 2(e)(1)                                                                                              | Refusal Affirmed                                                                                                                                    |                                                      | "MAYDAY" [electronic transceivers for vehicles for requesting emergency police, fire, and rescue service, emergency road service, and for requesting and receiving information] |                                            | Golden             | No                           |
| 12-8        | EX (R)          | 76536293                | Ice Creams and Coffee Beans, Inc.     | Rogers Drost* Walsh   | 2(d); Section 6 disclaimer requirement (of the words ICE CREAMS & COFFEE BEANS)                      | Request for Reconsideration Denied (Refusal Affirmed on both grounds)                                                                               |                                                      | "WHOLLY COW ICE CREAMS & COFFEE BEANS" [restaurant services]                                                                                                                    | "HOLY COW!" [bar and restaurant services]  | DuBois             | No                           |

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